REMARKS

The above-identified application is United States application serial number 10/792,150 filed on March 3, 2004. Claims 1-18 are pending in the application. Claims 1-18 are rejected. Applicant respectfully traverses these rejections.

Specification

Applicant has amended paragraphs [0001], [0018], [0021], and [0056] to replace the cited application serial numbers with patent numbers where appropriate. Removal of the objections to the disclosure is respectfully requested.

Rejection of Claim Under 35 USC §101

Claim 1 is rejected under 35 U.S.C. 101 because the method claims encompass pure software or program. In response, claim 1 recites:

> "A method of instrumenting Java components installed on an application server in order to enable the Java components to be monitored, the method comprising:
>
> adding a patch to a class loader class of a Java virtual machine installed on the application server, wherein the patch causes the class loader class to pass Java components to an instrumentation component when said Java components are loaded by the Java virtual machine;
>
> receiving, from a patched version of said class loader class, code of a Java component to be loaded by the Java virtual machine; and
>
> with the instrumentation component, instrumenting said code of the Java component to add functionality for tracking execution times." (Emphasis added).

On August 24, 2009, the U.S. Patent Office issued "New Interim Patent Subject Matter Eligibility Examination Instructions" that include a flowchart entitled "Subject Matter Eligibility Test For Process Claims" (hereinafter "the Flowchart"). Applying the flowchart to claim 1, Applicant submits the Flowchart's test of whether the claim requires the method to be implemented by a particular machine is met since the Java components to be instrumented are installed on an application server. The

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application server also enables claim 1 to meet the requirements of the second test in the Flowchart because the use of the application server imposes a meaningful limit on the claim's scope, and involves more than insignificant extra-solution activity. For example, as a result of installing the instrumentation component, the Java virtual machine and the application server are transformed with added functionality for tracking execution times.

Removal of the rejection of claim 1 under 35 U.S.C. 101 is respectfully requested.

Obviousness-Type Double Patenting

Claim 1 is rejected on obviousness-type double patenting grounds over claims 1, 7, and 8 of commonly-owned U.S. Pat. 6,792,460. In response, Applicant is filing a terminal disclaimer herewith to overcome this rejection.

Rejection of Claim Under 35 USC §103

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hind *et al*. (U.S. Pat. Pub. No. 2004/0054695) (hereinafter "Hind") in view of Morshed *et al*. (U.S. Pat. No. 6,721,941) (hereinafter "Morshed"). Claim 1 recites "with the instrumentation component, instrumenting said code of the Java component to add functionality for tracking execution times." In contrast, the combination of Hind and Morshed are cited together as teaching this feature, however, Morshed teaches away from instrumenting source code due to drawbacks associated with modifying and generating the code. (Morshed, col. 2 lines 13-25). Morshed instead teaches the use of Active Debug DLL and a debugging interface in connection with obtaining execution information with the JavaScript DLL and the VBScript DLL. (Morshed, col. 61 lines 11-25). Additionally, nothing in Hind or Morshed teaches or suggests that the probes are used to track execution times, as set forth in claim 1. Rather, the probes in Hind are used to generate trace data and implement patches for malfunctioning programs. These shortfalls of the prior art at the time the present

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application was filed are discussed in specification paragraph [0006]. Morshed does not discuss or suggest tracking execution times, but rather teaches how to determine "wire time", which is described as the actual time spent transmitting information on the wire or using communication connections between the client and the server. (Morshed, col. 50 lines 11-25). The execution time data referred to in Claim 1 is distinguishable from the prior art for at least these reasons.

Claims 2-18 depend from independent claim 1 and include features that further distinguish them over the cited references. For example, claim 3 recites "functionality for detecting when the Java component is invoked by a colored transaction request message so overhead associated with tracking the execution times is not incurred with respect to transactions executed by real users." This feature is supported by at least the abstract and paragraphs [0009], [0036], [0045], and [0061] of the specification. In contrast, Hind creates a list of patterns that match all of the specific classes that require the probes, but does not disclose or suggest that the patterns can be used to avoid the overhead associated with executing the probes with respect to transactions executed by real users. (Hind, para. [0044]). Claim 3 is further distinguishable from the cited reference for at least these additional reasons.

As a further example, claim 4 recites "functionality for reporting transaction identifiers of transactions that invoke the Java component, to thereby allow said execution times to be associated with transactions to which they correspond." In contrast, Hind only teaches logging trace data for malfunctioning application programs, not reporting transaction identifiers of transactions that invoke the Java component. Claim 4 is further distinguishable from the cited reference for at least these additional reasons.

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CONCLUSION

Applicants believe the application, including all remaining claims, is in form for allowance and a notice to that effect is solicited. In the event it would facilitate prosecution of this application, the Examiner is invited to telephone the undersigned at (949) 350-7301.

I hereby certify that this correspondence is being transmitted to the USPTO on the date shown below:

/Mary Jo Bertani/
(Signature)

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October 8, 2009
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